

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAMITSU YAMAMOTO et al.

Appeal No. 2000-0286
Application No. 08/704,031

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8 to 12, which are all of the claims pending in this application.¹

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

¹ Claim 8 was amended subsequent to the final rejection.

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BACKGROUND

The appellants' invention relates to a disposable absorbent undergarment. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Watanabe et al. 1992 (Watanabe)	GB 2 253 131 A	Sep. 2,
Tagawa et al. (Tagawa)	EP 0 623 331 A2	Nov. 9, 1994

Claims 8 to 12 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

Claims 8 to 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Watanabe in view of Tagawa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 12, mailed April 23, 1998) and the answer (Paper No. 24, mailed April 9, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 23, filed February 23, 1999) and reply brief (Paper No. 25, filed June 9, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The written description rejection

We will not sustain the rejection of claims 8 to 12 under 35 U.S.C. § 112, first paragraph.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039,

34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

The examiner determined (final rejection, p. 3) that claims 8 to 12 violated the written description requirement of the first paragraph of 35 U.S.C. § 112 due to the inconsistency of the description of the second elastic material (e.g., the claimed second elastic material referencing elastically stretchable members 15 while the specification referred to the second elastically stretchable members by reference number 14). The appellants admit (brief, p. 5) that there is an inconsistency between the terminology used in the claims under appeal and the specification and state that they are willing to file an amendment to make the claims consistent with the specification.² The appellants then go on to argue that notwithstanding the inconsistencies, the claims under appeal are described in the original specification in a way as to reasonably convey to one skilled

² Notwithstanding our reversal of this ground of rejection, we encourage the appellants to file such an amendment.

in the art that the inventors had possession of the now claimed invention.

In our view, the appellants' original disclosure does provide, with reasonable clarity, written description support for the claimed subject matter found objectionable by the examiner as set forth above. In that regard, the claims under appeal clearly recite first elastic material, second elastic material and third elastic material which one skilled in the art would reasonably know refer respectively back to the first elastically stretchable members 13, the elastically stretchable members 15 and the second elastically stretchable members 14. Accordingly, the decision of the examiner to reject claims 8 to 12 under 35 U.S.C. § 112, first paragraph, is reversed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against appellants' claims 8 to 12:

Claims 8 to 12 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention. The original disclosure (p. 10) provided that the liquid-absorbent pad included a **liquid-permeable topsheet** 38, a liquid-impermeable backsheet 39 and a liquid-absorbent panel disposed therebetween. Original claim 1 provided that the liquid-absorbent pad comprises a **liquid-permeable topsheet**, a backsheet and a liquid-absorbent panel disposed between these two sheets. Claim 8 (first presented in the amendment filed on June 13, 1997, Paper No. 7) recites that the liquid-absorbent pad comprises a **liquid-impermeable topsheet**, a backsheet and a liquid-absorbent panel disposed therebetween. After reviewing the original disclosure, we fail to find any written description support for the topsheet of the liquid-absorbent pad being **liquid-impermeable**.

The obviousness rejection

We will not sustain the rejection of claims 8 to 12 under 35 U.S.C. § 103.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Thus, even a claim limitation which lacks written description support cannot be disregarded.

In this case, the inner sheet 15 of Watanabe's absorbent body 3 (which corresponds to the claimed topsheet of the liquid-absorbent pad) is liquid permeable not liquid impermeable as claimed. Since the applied prior art would not have suggested making the inner sheet 15 of Watanabe's absorbent body 3 impermeable, we must reverse the decision of the examiner to reject claims 8 to 12 under 35 U.S.C. § 103.

Since in response to our new ground of rejection made above the appellants may amend claim 8 by changing "liquid-impermeable topsheet" to "liquid-permeable topsheet," we present our views on three issues of obviousness raised in the appeal to expedite any further prosecution of the claimed subject matter. First, it is our opinion that the claimed "said crotch section including a liquid-impermeable film stretchable at least in said longitudinal direction" would have been obvious at the time the invention was made to a person having ordinary skill in the art from the teachings of the applied prior art since Tagawa's teachings of a film in backsheet 3 (column 8, lines 21-28) would have been suggestive to modify Watanabe's outermost impermeable layer 2 to include a stretchable liquid-impermeable film. Second, it is our opinion that the claimed "said crotch section further including second elastic material extending between said pair of leg-openings so as to be stretchable transversely of said short pants, a portion of said second elastic material extending along rear side peripheries of said leg-openings and another portion of said second elastic material extending across said crotch section in proximity of said lower ends of

said leg-openings" would have been obvious at the time the invention was made to a person having ordinary skill in the art from the teachings of the applied prior art since Tagawa's teachings using either elastically expansible members 8 (see Figures 1-5) or elastically expansible members 115a and 115b (see Figures 6-10) would have been suggestive to modify Watanabe's elastic members 13 to be shaped as suggested by the elastically expansible members 115a and 115b of Tagawa.

Third, with respect to claim 9, it is our view that a prima facie case of obviousness has not been established since the examiner has not presenting any evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. In that regard, the mere fact that a difference (between the teachings of the prior art and the claimed subject matter) does not provide any new result or solve any recognized problem does not, *ipso facto*, make that difference obvious under 35 U.S.C. § 103. Thus, we view the examiner's reliance (answer, p. 7) on In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) to be misplaced in this instance.

CONCLUSION

To summarize, the decision of the examiner to reject claims 8 to 12 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 8 to 12 under 35 U.S.C. § 103 is reversed; and a new rejection of claims 8 to 12 under 35 U.S.C. § 112, first paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

ground of rejection to avoid termination of proceedings

(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
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